PATENT
Attorney Docket No. SKY03005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	)	**Mail Stop Appeal Brief – Patents**
	)	
Craig D. CHURCH	)	Group Art Unit: 3625
	)	
Application No.: 10/774,372	)	Examiner: William J. ALLEN
	)	
Filed: February 10, 2004	)	
	)	
For: APPARATUS AND METHOD FOR LOCATING ITEMS	)	

REPLY BRIEF UNDER 37 C.F.R. § 41.41

U.S. Patent and Trademark Office
Customer Window, Mail Stop Appeal Brief – Patents
Randolph Building
401 Dulany Street
Alexandria, Virginia 22314

Sir:

This Reply Brief is submitted in response to the Examiner's Answer dated December 26, 2007.

I. STATUS OF CLAIMS

A. Rejected Claims

1. Claims 1, 4, 7, 11, 12, 18, 20, 21, 23, 24, and 42-49 have been rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,317,718 to Fano (Fano) in view of U.S. Patent No. 6,937,998 to Swartz et al. (Swartz).

2. Claims 10, 14, 15, 19, and 25 have been rejected under 35 U.S.C. § 103(a) as unpatentable over Fano in view of Swartz and further in view of U.S. Patent Application Publication No. 2002/0194081 to Perkowski (Perkowski).

3. Claim 16 has been rejected under 35 U.S.C. § 103(a) as unpatentable over Fano in view of Swartz and further in view of U.S. Patent Application Publication No. 2002/0138372 to Ludtke (Ludtke).

4. Claims 17 and 26 have been rejected under 35 U.S.C. § 103(a) as unpatentable over Fano in view of Swartz and further in view of U.S. Patent Publication No. 2003/0027555 to Malackowski et al. (Malackowski).

B. Canceled Claims

Claims 2, 3, 5, 6, 8, 9, 13, 22, and 27-41 have been previously canceled without prejudice or disclaimer.

C. Appealed Claims

Claims 1, 4, 7, 10-12, 14-21, 23-26, and 42-49 are the subject of the present appeal.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Appellant respectfully requests that the following grounds of rejection be reviewed on appeal:

A. The rejection of claims 1, 4, 7, 11, 12, 18, 20, 21, 23, 24, and 42-49 under 35 U.S.C. § 103(a) as obvious over Fano in view of Swartz;

B. The rejection of claims 10, 14, 15, 19, and 25 under 35 U.S.C. § 103(a) as unpatentable over Fano in view of Swartz and Perkowski;

C. The rejection of claim 16 under 35 U.S.C. § 103(a) as unpatentable over Fano in view of Swartz and Ludtke; and

D. The rejection of claims 17 and 26 under 35 U.S.C. § 103(a) as unpatentable over Fano in view of Swartz and Malackowski.

III. ARGUMENTS

In the "Response to Argument" section of the Examiner's Answer (pp. 11-13), the Examiner relies on new arguments regarding the disclosure of the Fano reference that have not previously been relied on in rejecting Appellant's claims. Appellant objects to the Examiner introducing these new arguments for the first time in the Examiner's Answer, particularly since the Examiner has relied on Fano since the first Office Action and has had plenty of opportunities to introduce these new arguments. Nevertheless, the following remarks address each of the new arguments raised by the Examiner in the Examiner's Answer.

A. The rejection of claims 1, 4, 7, 11, 12, 18, 20, 21, 23, 24, and 42-49 under 35 U.S.C. § 103(a) should be reversed.

Claims 1, 4, 7, 11, 12, 18, 20, 21, 23-24, and 42-49 stand rejected under 35 U.S.C. § 103(a) as obvious over Fano in view of Swartz. Appellant respectfully appeals these rejections.

1. Claim 1

Independent claim 1 recites:

> A method comprising:
> determining whether a portable device is or is not located within a first site;
> wherein when the portable device is located within the first site:
> sending a menu of items located at the first site to the portable device for displaying to a user,
> receiving, from the portable device, a selection by the user of at least one item from the menu of items located at the first site, and
> sending location information regarding the at least one item selected from the menu of items at the first site to the portable device for displaying to the user; and
> wherein when the portable device is not located within the first

site:

sending to the portable device a menu of sites located within a vicinity of the portable device for displaying to the user, and

receiving from the portable device a selection of a second site from the menu of sites by the user.

In addressing the rejection of claim 1 in the Examiner's Answer, the Examiner incorrectly contends that Fano discloses "determining whether a portable device is or is not located within a first site," as recited in claim 1. In making this contention, the Examiner states that "[a] store closest to the user containing items of interest constitutes a *first site*." See Answer at p. 4 (italic in original). The Examiner, however, implicitly acknowledges that Fano does not disclose "determining whether a portable device is or is not located within a first site," by repeatedly contending that Fano discloses "when the device is within range of the store having items of interest." See Answer at p. 4 (underline added); see also p. 5 ("when the portable device is not within range of the first site and is within range of a second site") (underline added); p. 7 ("when the portable device is not within range of the first site (store containing items of interest) and is within range of a second site (a store not containing the items of interest)") (underline added); and p. 12 ("Fano is able to . . . determine whether the location of the user is within a range of a first site having specified items of interest or not within a first site") (underline added).

In the Answer, the Examiner now contends that "within a range," as allegedly disclosed by Fano, is "analogous" to what is claimed:

> The Examiner hereby asserts that, in teaching where a user within range of a store carrying items of interest is notified of those items of interest within the store, Fano effectively teaches analogous functionality to that of the claims.

Answer at p. 12 (underline added here). Applicants respectfully disagree. The sections of Fano

cited by the Examiner (Answer at p. 4 and 12) discuss "nearby stores," "immediately surrounding stores," and "currently closest" stores. For example, at column 47, lines 20-24 and 61-66, Fano discloses:

> A preferred embodiment of a system utilizes a Windows CE PDA equipped with a GPS receiver. The embodiment is configured for a mall containing a plurality of stores. The system utilizes a GPS receiver to determine the user's location. One advantage of the system is that it enables the retrieval of data for nearby stores without relying on the presence of any special equipment at the mall itself. Although the accuracy of smaller, inexpensive receivers is limited to approximately 75-100 feet, this has thus far proven to be all that is necessary to identify accurately the immediately surrounding stores.
>
> * * *
>
> The display operates in a browse mode for use by shoppers as they stroll through the mall. In browse mode the system suggests items of interest for sale in the stores currently closest to the shopper. An item is considered to be of interest if it matches the categories entered in the goals screen.

These sections of Fano disclose determining the "closest," "nearby," or "immediately surrounding" stores. This determining in Fano is different than (and not "analogous" to) determining when the device is located "within the first site," as recited in claim 1. In fact, Fano teaches away from "determining whether a portable device is or is not located <u>within</u> a first site," as recited in claim 1. Fano describes "all that is necessary" to identify "immediately surrounding stores" (col. 47, lines 20-24), without ever "determining whether a portable device is or is not located <u>within</u> a first site," as recited in claim 1 (underline added here). Thus, Fano does not disclose or suggest at least "determining whether a portable device is or is not located within a first site," as recited in claim 1.

Further, the Examiner does not contend that Swartz discloses or suggests "determining whether a portable device is or is not located within a first site," as recited in claim 1. Thus, the Examiner has not satisfied the initial burden of establishing a prima facie basis to deny patentability to the claimed invention. At least for the foregoing reasons, Appellant submits that claim 1 is patentable over the combination of Fano and Swartz.

In addition, Fano does not disclose or suggest "sending location information regarding the at least one item selected from the menu of items at the first site to the portable device for displaying to the user," as recited in claim 1. The Examiner cites to Fano, column 48, lines 22-25, for allegedly disclosing this feature. See Answer at p. 5. This portion of Fano recites:

> If an item displayed is selected by the shopper while browsing, the system alerts the shopper to the local retailer offering the same product for the lowest price, or announces the best local price.

The Examiner equates "alert[ing] the shopper to the local retailer offering the same product for the lowest price," as disclosed in Fano to "sending location information regarding the . . . item selected from the menu of items at the first site," as claimed. See Answer at p. 5. First, as disclosed in Fano, "the item" selected by the shopper is not located at the "local retailer." Instead, Fano discloses that the "same product" as "the item" selected by the shopper is at the "local retailer." In other words, Fano discloses alerting the shopper to a different store carrying a different item (albeit the different item is "the same" product as the selected item). Therefore, Fano does not disclose or suggest "sending location information regarding the at least one item selected from the menu of items at the first site," as claimed in claim 1.

Further, the Examiner does not contend that Swartz discloses or suggests "sending

location information regarding the at least one item selected from the menu of items at the first site to the portable device for displaying to the user," as recited in claim 1. Swartz discloses a "portable terminal carried by a user and in wireless communication with a local area network for displaying data based on the physical location of the user." See Abstract. Swartz also discloses "base stations located in a common area . . . for general information gathering processes." Col. 9, lines 38-41. Swartz does not disclose or suggest "sending location information regarding the at least one item selected from the menu of items at the first site to the portable device for displaying to the user," as recited in claim 1.

Thus, the Examiner has not satisfied the initial burden of establishing a prima facie basis to deny patentability to the claimed invention. At least for the foregoing reasons, Appellant submits that claim 1 is patentable over the combination of Fano and Swartz.

2. Claim 11

Claim 11, which ultimately depends on claim 1, further defines "location information." Claim 11 recites, "wherein the location information includes a location of each of the at least one selected item . . . ." As disclosed in Fano, "the item" selected by the shopper is not located at the "local retailer." Instead, Fano discloses that the "same product" as "the item" selected by the shopper is at the "local retailer." In other words, Fano discloses alerting the shopper to a different store carrying a different item (albeit the different item is "the same" product as the selected item). Therefore, Fano does not disclose or suggest "sending location information," where "location information includes a location of the at least one selected item," as claimed.

Further, Swartz does not cure the deficiencies of Fano. Swartz also does not disclose or suggest "wherein the location information includes a location of each of the at least one selected item," as recited in claim 11. Further, the Examiner does not contend that Swartz discloses or suggests this feature of claim 11.

In addition, claim 11 depends on claim 1 and includes all the features of claim 1. Because the combination of Fano and Swartz does not render claim 1 obvious, these references also cannot render claim 11 obvious.

Therefore, at least for the foregoing reasons, Appellant respectfully requests the withdrawal of the rejection of claim 11 under § 103(a).

3. Claims 4, 7, and 42

In addition, claims 4, 7, and 42 depend on claim 1 and include all the features of claim 1. Because the combination of Fano and Swartz does not render claim 1 obvious, these references also cannot render claims 4, 7, and 42 obvious. Therefore, Appellant respectfully requests the withdrawal of the rejection of claims 1, 4, 7, and 42 under § 103(a).

4. Claims 12, 18, and 43

Although claim 12 is of different scope than claim 1, claim 12 includes some similar features and language as claim 1. For example, claim 12 recites, among other things, "determin[ing] whether the portable device is or is not located within a first site." In addition, claim 12 recites, "receiv[ing] location information regarding the at least one item selected from the menu of items at the first site from the server for displaying on the display."

The Examiner presents the same evidence for claim 12 as claim 1. Thus, for similar reasons given above with respect to claim 1, Appellant submits that claim 12 is patentable over the combination of Fano and Swartz.

Claims 18 and 43 depend on claim 12 and include all the features of claim 12. Because Fano and Swartz do not render claim 12 obvious, these references also cannot render claims 18 and 43 obvious. Therefore, Appellant respectfully requests the withdrawal of the rejection of claims 12, 18, and 43 under § 103(a).

5. Claims 20, 21, 23, 24, and 44

Although claim 20 is of different scope than claim 1, claim 20 includes some similar features and language as claim 1. For example, claim 20 recites, among other things, "determin[ing] whether a portable device is or is not located within a first site." Claim 20 also recites, "send[ing] the location information regarding the at least one item."

The Examiner presents the same evidence for claim 20 as claim 1. Thus, for similar reasons given above with respect to claim 1, Appellant submits that claim 20 is patentable over the combination of Fano and Swartz.

Claims 21, 23, 24, and 44 depend on claim 20 and include all the features of their respective base claim. Because claim 20 is patentable over the combination of Fano and Swartz, Appellant submits that claims 21, 23, 24, or 44 are also patentable over the combination of Fano and Swartz. Therefore, Appellant respectfully requests the withdrawal of the rejection of claims 20, 21, 23, 24, and 44 under § 103(a).

6. Claims 45, 46, and 47

Although claim 45 is of different scope than claim 1, claim 45 includes some similar features and language as claim 1. For example, claim 45 recites, among other things, "determining whether a portable device is or is not located within a first site." Claim 45 also recites, "sending location information regarding the at least one item."

The Examiner presents the same evidence for claim 45 as claim 1. Thus, for similar reasons given above with respect to claim 1, Appellant submits that claim 45 is patentable over the combination of Fano and Swartz.

Claims 46 and 47 depend on independent claim 45 and include all the features of claim 45. Because claim 45 is patentable over the combination of Fano and Swartz, Appellant submits that claims 46 and 47 are also patentable over the combination of Fano and Swartz. Therefore, Appellant respectfully requests the withdrawal of the rejection of claims 45, 46, and 47 under § 103(a).

7. Claims 48 and 49

Although claim 48 is of different scope than claim 1, claim 48 includes some similar features and language as claim 1. For example, claim 48 recites, among other things, "determining whether a portable device is or is not located within a first site." The Examiner presents the same evidence for claim 48 as claim 1. Thus, for at least similar reasons given above with respect to claim 1, Appellant submits that claim 48 is patentable over the combination of Fano and Swartz.

Claim 49 depends on independent claim 48 and includes all the features of claim 49. Because claim 48 is patentable over the combination of Fano and Swartz, Appellant submits that claim 49 is also patentable over the combination of Fano and Swartz. Therefore, Appellant respectfully requests the withdrawal of the rejection of claims 48 and 49 under § 103(a).

B. The rejection of claims 10, 14, 15, 19, and 25 under 35 U.S.C. § 103(a) should be reversed.

Claims 10, 14, 15, 19, and 25 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Fano in view of Swartz and Perkowski. This rejection is respectfully traversed.

Claims 10, 14, 15, 19, and 25 depend on one of independent claims 1, 12, or 20 and include all the features of their respective base claim. For at least the reasons set forth above, claims 1, 12, or 20 are patentable over the combination of Fano and Swartz. Appellant respectfully submits that the disclosure of Perkowski does not cure the deficiencies of Fano and Swartz described above with respect to claims 1, 12, and 20.

Perkowski discloses an internet-based consumer service to carry out service-related functions along the demand side of a retail chain. See Abstract. Appellant submits that Perkowski does not disclose or suggest, for example, determining whether a portable device is or is not located within a first site or sending location information regarding the at least one item, as required by claims 10, 14, 15, 19, and 25. Appellant also submits that Perkowski does not disclose or suggest, for example, "sending location information regarding the at least one item selected from the menu of items at the first site to the portable device for displaying to the user," as required by claim 10. Further, Appellant submits that Perkowski does not disclose or suggest,

for example, "receiv[ing] location information regarding the at least one item selected from the menu of items at the first site from the server for displaying on the display," as required by claims 14, 15, and 19. In addition, Appellant submits that Perkowski does not disclose or suggest, for example, "send[ing] the location information regarding the at least one item," as required by claim 25.

Because none of Fano, Swartz, or Perkowski, alone or in reasonable combination, disclose or suggest all the features of claims 10, 14, 15, or 25, Appellant respectfully requests the withdrawal of the rejection of claims 10, 14, 15, 19, and 25 under § 103(a).

C. The rejection of claim 16 under 35 U.S.C. § 103(a) should be reversed.

Claim 16 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Fano in view of Swartz and Ludtke. This rejection is respectfully traversed. Claim 16 depends on claim 12 and includes all the features of claim 12. Appellant submits that the disclosure of Ludtke does not cure the deficiencies of Fano and Swartz described above with respect to claim 12.

Ludtke discloses a "system and method for locating items." See Abstract. Appellant submits that Ludtke does not disclose or suggest, for example, determining whether a portable device is or is not located within a first site or receiving location information regarding the at least one item, as required by claim 16. Appellant also submits that Ludtke does not disclose or suggest, for example, "receiv[ing] location information regarding the at least one item selected from the menu of items at the first site from the server for displaying on the display," as required by claim 16.

Because none of Fano, Swartz, or Ludtke, alone or in reasonable combination, discloses or suggests all the features of claim 16, Appellant respectfully requests the withdrawal of the rejection of claim 16 under § 103(a).

D. The rejection of claims 17 and 26 under 35 U.S.C. § 103(a) should be reversed.

Claims 17 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fano in view of Swartz and Malackowski. This rejection is respectfully traversed.

Claims 17 and 26 depend on independent claims 12 or 20, respectively, and include all the features of their respective base claims. For at least the reasons set forth above, claims 12 or 20 are patentable over the combination of Fano and Swartz. The disclosure of Malackowski does not cure the deficiencies of Fano or Swartz identified above with respect to claims 12 and 20.

For example, Appellant submits that Malackowski does not disclose or suggest determining whether a portable device is or is not located within a first site as required by claims 17 and 26. In addition, Appellant submits that Malackowski does not disclose or suggest "receiv[ing] location information regarding the at least one item selected from the menu of items at the first site from the server for displaying on the display," as required by claim 17. Further Appellant submits that Malackowski does not disclose or suggest "send[ing] the location information regarding the at least one item," as required by claim 26.

Because none of Fano, Swartz, or Malackowski, alone or in reasonable combination, discloses or suggests all the features of claims 17 and 26, Appellant respectfully requests the withdrawal of the rejection of claims 17 and 26 under § 103(a).

VIII. CONCLUSION

In view of the foregoing arguments, Appellant respectfully solicits the Honorable Board to reverse the Examiner's rejections of claims 1, 4, 7, 11, 12, 18, 20, 21, 23, 24, and 42-49. In addition, as Appellant's remarks with respect to the Examiner's rejections are sufficient to overcome the rejections, Appellant's silence as to assertions by the Examiner in the Answer or Final Office or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art) is not a concession by Appellant that such assertions are accurate or such requirements have been met, and Appellant reserves the right to analyze and dispute such in the future.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 50-1070 and please credit any excess fees to such deposit account.

Respectfully submitted,
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